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**THIS DISPOSITION  
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Paper No. 15  
EWH

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Lush Ltd.

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Serial No. 75/535,140

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Frederick H. Rabin of Fish & Richardson for Lush Ltd.

Jeffrey S. Molinoff, Trademark Examining Attorney, Law  
Office 107 (Thomas Lamone, Managing Attorney).

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Before Hanak, Wendel and Holtzman, Administrative Trademark  
Judges.

Opinion by Hanak, Administrative Trademark Judge.

Lush Ltd. (applicant) seeks to register BALLISTIC for  
"non-medicated bath salts containing effervescent  
materials, perfumes, emollients, moisturizers and oil for  
the skin." The application was filed on August 13, 1998  
with a claimed first use date of July 1994. As substitute  
specimens of use, applicant filed the following:

The Examining Attorney has refused registration on the basis that applicant's specimens of use "do not show use of the mark [BALLISTIC] as depicted on the drawing page of the application." (Examining Attorney's brief page 1). It is the position of the Examining Attorney that applicant's mark is not BALLISTIC per se, but rather is THE BALLISTIC BARREL. (Examining Attorney's brief page 2).

When the refusal to register was made final, applicant appealed to this Board. Applicant and the Examining Attorney filed briefs. Applicant requested and then waived an oral hearing.

The leading case dealing with a situation where an applicant attempts to register what is arguably only a part of its trademark is In re Servel, Inc., 181 F.2d 192, 85 USPQ 257 (CCPA 1950). In that case, applicant sought to register SERVEL despite the fact that the specimens of use showed that the title of applicant's periodical was SERVEL INKLINGS. In reversing the refusal to register SERVEL per se, the Court stated that "the courts in a proper case may recognize the right to registration of one part of an owner's mark consisting of two parts." 85 USPQ at 260.

In view of the holding in Servel, this Board has been quite liberal in allowing applicants to register what are arguably only portions of the trademarks shown on the specimens of use. For example, this Board allowed registration of DUMPMASER based upon the following specimen of use:

In so doing, this Board stated that "there can be no question but that the composite shown above constitutes two distinct terms, each of which is capable of distinguishing applicant's goods from like goods, if they were to be used separably as trademarks." In re Dempster Bros., Inc., 132 USPQ 300 (TTAB 1961). In allowing registration of DUMPMAS<sup>T</sup>ER per se, the Board was not troubled by the fact that the words DEMPSTER and DUMPMAS<sup>T</sup>ER were totally intertwined in that they shared the same large first letter and the same large final letter (i.e. the D and the R).

In a more recent decision, this Board allowed the registration of the mark TINEL-LOCK based upon the following specimen of use:

In so doing, the Board was not concerned with the fact that the mark sought to be registered (TINEL-LOCK) was joined with hyphens to the model number (TRO6AI) and the generic term (RING). In re Raychem Corp., 12 USPQ2d 1399 (TTAB 1989).

In stark contrast to the Dempster and Raychem cases, in the present case the mark sought to be registered (BALLISTIC) is physically separated from the two other elements in the substitute specimen, namely, the words THE and BARREL. It has long been held that words such as "the" and "a" have little if any source identifying significance. As for the word "barrel," while it is not descriptive of applicant's bath salts, it is a generic term for the containers which applicant claims house the salts, namely, barrels. In this regard, we note that the Examining Attorney has never disputed that applicant's bath salts are packaged in barrels. (Examining Attorney's brief page 6).

In view of the foregoing, we find that as depicted in applicant's substitute specimens of use, the word BALLISTIC functions as a source identifying word, that is, as a trademark. Consumers viewing applicant's specimen labels on barrels containing bath salts would, in our judgment, accord very little weight to the word THE and would view the word BARREL as simply indicating that the bath salts come in a barrel. We recognize that applicant's identification of goods does not contain a limitation that applicant's bath salts will always be sold in barrels.

However, in both the Dempster and Raychem cases, this Board looked to the applicants' advertising which on many occasions used DUMPMAS<sup>T</sup>ER per se and TINEL-LOCK per se. Obviously, said advertising could have been changed at any time. Nevertheless, this Board accorded said advertising some evidentiary value in finding that DUMPMAS<sup>T</sup>ER and TINEL-LOCK functioned as trademarks by themselves. While it is theoretically possible that in the future applicant could package its bath salts in, for example, boxes as opposed to barrels, then it would make no commercial sense to use the phrase THE BALLISTIC BARREL.

Decision: The refusal to register is reversed.

Holtzman, dissenting.

I respectfully dissent from the reasoning and conclusion of the majority that the word BALLISTIC, alone, functions as a mark for applicant's goods. It is well settled that a particular element of a composite mark is registrable only if that element creates a separate and distinct commercial impression as a mark. See *In re Berg Electronics, Inc.*, 163 USPQ 487 (TTAB 1969) citing *In re Schenectady Varnish Company, Inc.*, 126 USPQ 395 (CCPA 1960). I find that the designation THE BALLISTIC BARREL is visually and conceptually a unitary expression and I agree

with the Examining Attorney that the single word BALLISTIC, as shown on the specimens, does not make a commercial impression separate and apart from the other two words in the phrase.

In deciding that the word BALLISTIC is a registrable mark, the majority points to the physical separation of the individual words on applicant's specimens as well as the lack of trademark significance of the word THE and the genericness of the word BARREL in relation to the containers for applicant's goods.

Applicant's substitute specimens, the only evidence of applicant's use of the phrase sought to be registered, show that the words THE BALLISTIC BARREL convey a unitary impression. No single word stands out visually more than the other. Each word appears in the same size, style, color and display. In addition, it is quite clear, despite the physical separation of the words, that the designation is intended to be read as a unitary three-word phrase and that the meaning is conveyed by the phrase as a whole. See, for example, in *In Ipco Corp. v. Blessings Corp.*, 5 USPQ2d 1974 (TTAB 1988), wherein the Board found that the opposer's use of word CONFIDENCE on its brochures did not constitute a separate mark and would be perceived as an "integral and natural" part of the phrase "CONFIDENCE TO

ENJOY A NORMAL AND ACTIVE LIFE," notwithstanding the appearance of the word CONFIDENCE in a larger size and in a different color than the rest of the phrase.

I do not believe that the cases cited by the majority (In re Servel, 181 F.2d 192, 85 USPQ 257 (CCPA 1950), In re Dumpster Bros., Inc., 132 USPQ 300 (TTAB 1961) and In re Raychem Corp., 12 USPQ2d 1399 (TTAB 1989)) support the analysis of the majority or ultimately the registration of this mark.

The majority relies on the following statement from the Court's opinion in *Servel*: "The courts in a proper case may recognize the right to registration of one part of an owner's mark consisting of two parts." However, the key wording in that quote is "a proper case" meaning of course a case in which the part sought to be registered functions separately as a mark. Thus, *Servel* does not authorize what the majority permits here, the extraction of one word from an otherwise unitary phrase for registration as a separate mark.

The majority notes that the Board in *Dempster Bros.*, "was not troubled by the fact that the words DEMPSTER and DUMPMASER were totally intertwined...." However, in that case, the Board based its decision not on the physical relationship of the words but on applicant's persuasive

evidence (such as advertisements, media references, purchase orders, purchaser affidavits) showing that DUMPMASTER alone was promoted and perceived as a separate mark. There is no evidence in the present record to indicate that the word BALLISTIC would be perceived as a separate mark. The only evidence of applicant's use in this case is the specimens and, as noted above, those specimens show that the words THE BALLISTIC BARREL convey a unitary visual and connotative impression.

The majority also relies on the *Raychem* case wherein the Board found that the designation TRO6AI-TINEL-LOCK-RING, despite the hyphenation, did not create a unitary expression and that therefore neither the stock number "TRO6AI" nor the generic term "RING" were deemed "essential to the commercial impression" of TINEL-LOCK as a mark. Applying the reasoning of *Raychem* to the present case, there is no question that the words "THE" and "BARREL" are integral elements of the unitary expression THE BALLISTIC BARREL and that they are essential to the commercial impression created by the phrase. Thus, the fact that those words, standing alone, may be generic or have no trademark significance does not justify registration of BALLISTIC alone.



The Board in *In re Jane P. Semans*, 193 USPQ 727 (TTAB 1976), addressed this very issue, rejecting the applicant's contention in that case that the word "KRAZY" was registrable apart from the composite phrase KRAZY MIXED-UP because of the descriptive nature of the term "MIXED-UP." The Board affirmed the refusal to register KRAZY alone pointing out that "... 'KRAZY MIXED-UP' is a unitary phrase, of which 'KRAZY' is an integral part, ..." and further noting that "there is nothing in the record to suggest that customers and prospective purchasers of applicant's goods separate the phrase into component parts and utilize 'KRAZY' alone to call for and refer to the goods." 193 USPQ at 727. Similarly here also, there is nothing in the record to suggest that those seeking applicant's goods would separate the word "BALLISTIC" from the phrase THE BALLISTIC BARREL and use that word to call for applicant's goods.

For the above reasons, I would find that BALLISTIC does not function as a mark separate and apart from the entire phrase THE BALLISTIC BARREL and I would affirm the refusal to register.